

APPLICATION NO. 10/697,064
ATTORNEY DOCKET NO. 10030676-1
Page 4 of 5

REMARKS

Applicant respectfully requests entry of the foregoing amendments prior to examination of the application. Upon entry of the foregoing amendments, claims 1-14 are pending in the application. Claim 9 has been amended. The foregoing claim amendments are made to clarify that the subject matter of claims 9-14 is not mutually exclusive with the subject matter of independent claim 1 from which claims 9-14 depend. No substantive limitations have been added to the claims based on prior art. Therefore, no prosecution history estoppel arises from these amendments.

ELECTION/RESTRICTION

The Office Action alleges that the present application "contains claims directed to the following patentably distinct species of the claimed invention: Any one species in figures 1-9."

The Office Action further requires the election of a single disclosed species to which the claims shall be restricted if no generic claim is finally held to be allowable. The Office Action adds that no claims are generic to all figures.

Applicant provisionally elects with traverse to prosecute the species of the invention disclosed in Fig. 4 (claims 1-8).

Applicant initially notes that figures 1, 2A, 2B, 3A and 3B are included for further understanding of the background of the present application.

Applicant further notes that at least the requirement for election of species regarding the subject matter of figures 4, 5A-5D and 6-9 appears to be improperly drawn and should be withdrawn. The amplifier of figure 9 is a sub-species of the driver of figure 4. The circuit configurations for the matching circuit of figure 4 shown in figures 5A-5D are sub-species of the matching circuit of figure 4. Furthermore, the alternative top views of an optoelectronic device and one or more passive devices in figures 6-8 are sub-species of the optoelectronic device and the matching circuit recited in independent claim 1. Moreover, the circuits of figures 4 and 9 do not show embodiments with mutually exclusive characteristics as required to make a proper election of species requirement. In this regard, Applicant refers to MPEP § 806.04(f), which states in relevant part:

APPLICATION NO. 10/697,064
ATTORNEY DOCKET NO. 10030676-1
Page 5 of 5

[t]he general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first.

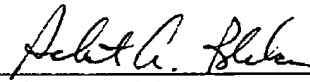
Thus, this test requires that the subject matter of claims have **mutually exclusive** subject matter, as disclosed in the specification, for restriction to different species. In this case, claims 2-14 recite features of the apparatus of Fig. 4. Thus, the elements in claims 2-14 are not "found in a first species but not in a second." Accordingly, the present election requirement for a species associated with one of figures 4-9 is improper and Applicant requests its withdrawal. Further, Applicant respectfully requests that claims 1-14 be examined.

Should the Examiner have any comments regarding the Applicant's response, Applicant requests that the Examiner telephone Applicant's undersigned attorney.

Respectfully submitted,

SMITH FROHWEIN TEMPEL
GREENLEE BLAHA LLC

By:


Robert A. Blaha
Registration No. 43,502
(770) 709-0069